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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/150,360	09/09/98	VERAZUNIS	W MERL-1197

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EXAMINER

LE,V

ART UNIT

PAPER NUMBER

2713

DATE MAILED:

03/07/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/150,360

Applicant(s)

YERAZUNIS ET AL.

Examiner

Vu Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 1999.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) _____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 14) ☒ Notice of References Cited (PTO-892)
- 15) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 16) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 17) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 18) ☐ Notice of Informal Patent Application (PTO-152)
- 19) ☐ Other: _____.

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Response to Arguments

1. Applicant's arguments with respect to claims 1-40 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-2, 6-7, 16-18 and 36-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang, PN 5342054 in view of Black, PN 4835621 for the same reasons as set forth in the last Office Action, Paper No. 3.
4. Claims 3-5, 19-22 and 24-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang in view of Black as applied to claims 1 and 16 above, and further in view of McHahan, PN 5845165 for the same reasons as set forth in the last Office Action, Paper No. 3.
5. Claims 8-11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang in view of Black as applied to claim 6 above, and further in view of Fielder, PN 5845240 for the same reasons as set forth in the last Office Action, Paper No. 3.
6. Claims 12, 15 and 31-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang in view of Black as applied to claim 1 above, and further in

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view of Scerbo, PN 5546124 for the same reasons as set forth in the last Office Action, Paper No. 3.

7. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chang in view of Black and Fielder as applied to claim 12 above, and further in view of Scerbo for the same reasons as set forth in the last Office Action, Paper No. 3.

8. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chang in view of Black and McMaha as applied to claim 22 above, and further in view of Fielder for the same reasons as set forth in the last Office Action, Paper No. 3.

9. Claims 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang in view of Black as applied to claim 16 above, and further in view of Scerbo and Hashimoto, PN 5815205 for the same reasons as set forth in the last Office Action, Paper No. 3.

Response to Remarks

Applicants argue that the Chang patent is a non-analogous art because it is directed to a golf practice apparatus for obtaining and storing a golfer's swing, whereas, the present application is directed to video recording mountable to a gun for recording video images before and after the firing of a gun.

It is true the fields of application between Chang and the present invention are different, however, the basic question remains. Is the Chang patent pertinent to the particular problem with which the inventor was concerned? The examiner believes the answer is yes.

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The mere argument that a reference is a non-analogous art is insufficient. Non-analogous art is twofold. See In re Pagliaro, 210 USPQ 888 (CCPA 1981), also In re Antle, 170 USPQ 285, 287 (CCPA) and In re Ellis, 177 USPQ 526 (CCPA). The first test determines if the reference is within the field of the inventor's endeavor. In the instant case, Chang is not. However, if it is not, is the reference reasonably pertinent to the particular problem with which the inventor was involved? In the instant case, it is believed Chang meets the second test.

The basic premise of the claimed invention is to have a video camera records images before and after an event. The occurrence of said event triggers the video recording process. Whatever the event may be is immaterial. In Chang, the event is a golf swing, and in the present application, the event is the firing of a firearm. However, the basic premise utilized in the claimed invention is substantiated by Chang as set forth in the last Office Action (see p. 2, paragraph 3).

Applicants further argue that Chang fails to disclose "repeatedly storing video image data" as claimed. The examiner disagrees. In Chang (col. 2, lines 32-41), a circular memory is utilized to store a complete golf swing. It is obvious that usage of the circular memory enables continuous recording of the golf swing. Thus, continuous recording is congruent with repeatedly recording as claimed.

Applicants acknowledge that the supporting reference Black teaches mounting a video camera to a weapon, but argue that Black is not pertinent to the claimed invention because it utilizes a video cassette tape for recording whereas the present invention

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utilizes a semiconductor memory. Applicants is reminded that Black was patented in 1989. At that time, the availability, efficacy, feasibility and cost of using semiconductor memory are major factors why one skilled in the art would not have opted it for recording purposes. Furthermore, advances in digital memory for consumer usage are at an infant stage. On the other hand, magnetic tape for recording is well known and used and is readily available for consumer applications. At present, semiconductor memory is a common commodity due to advances in the art. Thus, one skilled in the art would have been motivated to opt for semiconductor memory as opposed to magnetic tape as the recording medium of choice because of size factor, flexibility and robustness against wear and tear, and inter alia. Thus, it is viewed that applicants' usage of semiconductor memory as opposed to video cassette tape for video recording is a matter of choice obvious to one skilled in the art, and not a novel concept as asserted. The bottom line is that Black obviates the idea of mounting a video camera onto a firearm for recording the firing of said firearm.

In the last Office Action, the examiner in charge takes Official Notice that the usage of accelerometers or microphones to generate a trigger signal is well known and would have been obvious to serve as a substitute to the optical sensor in Chang. Applicants have challenged said Official Notice. To substantiate the examiner's position, US patent 4348277 to Cowlin et al is provided for applicants' perusal. In Cowlin (col. 8, lines 44-49), it is suggested that either a microphone or an accelerometer can be used as a trigger. Therefore, the idea of using either a microphone or an

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accelerometer as a trigger as claimed is not novel, but rather an old art rendered obvious by Cowlin et al.

Applicants further argue that the McMahan reference relied upon teaches the use of a trigger switch to activate a camera, not a video recording device as claimed. The examiner finds this argument trivial. Despite the difference between the camera and the video recording device as highlighted by the applicants, the basic premise here is the idea of using a trigger switch to activate an appliance. Thus, it is viewed the reliance of McMahan as a teaching reference is proper.

It appears that applicants are attacking the references used in the prior art rejection based on their individual merits. However, such attempt has been considered by the court improper. The prior art rejection under 35 USC 103 is based on combination of references. One cannot show non-obviousness by attacking references individually. In re Keller, 208 USPQ 871 (CCPA 1981). Furthermore, In re McLaughlin, 170 USPQ 209 (CCPA 1971) states that "[T]he test for combining references is not what the individual references themselves suggest but rather what the combination of the disclosures taken as a whole would suggest to one of ordinary skill in the art[.]"

Applicants further argue that Chang only teaches random access memory (RAM), whereas the claimed invention utilizes "dynamic" random access memory (DRAM). The argument is well noted. However, DRAM is also well known and used in the art, and would have been obvious to use as an alternative to RAM. Applicants argument does not indicate that using DRAM is critical, that is, DRAM is the only type of

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memory applicable. Thus, it leaves the examiner to conclude that using DRAM as opposed to RAM is a simple matter of obvious design choice.

Applicants further argue that Fielder is only pertinent to storing audio data, and not video data as alleged by the examiner. Upon further review, the citation made by the previous examiner (i.e., col. 4, lines 21-49) appears to talk only about audio data. However, the examiner is correct to note that Fielder teaches digital recording of sound and/or video of multiple events in circular buffers. (See col. 1, lines 11-16; col. 11, line 60 to col. 12, line 8).

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


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Contacts

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Vu Le whose telephone number is (703) 308-6613 and email is "Vu.Le@uspto.gov". The examiner can normally be reached on Monday to Friday from 8:30 AM to 5:00 PM.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700 or Customer Service whose number is (703) 308-6789.

The fax number for submitting formal communications is (703) 308-5359.


VULE
PRIMARY EXAMINER